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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,786

06/14/2005

Migaku Suzuki

124247

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25944

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03/31/2009

OLIFF & BERRIDGE, PLC

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

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DELIVERY MODE

03/31/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,786	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-2-09 has been entered.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

### ***Drawings***

2. The drawings were received on 1-2-09. These drawings are not approved. For example, the sheets with new Figures 15C and 16C and D are not replacement sheets, but rather new sheets and should have been properly identified "New Sheet". It is not that the Figures filed 5-27-08 were not approved. Also the new sheets of Figures are of poor quality, e.g. the arrow from 14 shown in Figure 16(D). Also, descriptive text has not yet been removed and new text is actually being added to proposed new Figures. Also with regard to claims 26-27 and 38-39, e.g.

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claims a housing continued to the internal space and a surface sheet which is between the space and the housing, but the space is formed when worn, i.e. Figure 15(B) of the application does not show the internal space when worn (It is noted that the Figure on page 13 of the remarks is not the same as that in Figure 15(B), e.g., Figure 15(B) does not show the worn state or both worn and unworn states with, e.g., one state shown in phantom and/or denote, e.g., the space and use such denotation in the textual description and/or is such Figure described as being in a particular state, e.g. worn or unworn or both, e.g. on pages 11-15). Therefore see the following paragraphs.

3. The drawings are objected to because Figures 30A-B should be labeled as “Prior Art”. Also, descriptive text, e.g. “DISCHARGED LIQUID”, should be avoided in the Figures. The Figures are not consistent with the description thereof as now amended, e.g. on pages 11-15 or page 27, line 12, e.g. where are portions 20 as described shown in Figures 7(C) -7(E) . See also discussion infra. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 26, 38, and thereby claims 27 and 39 which depend therefrom, see also discussion *infra* and *supra*, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Description***

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 43, fourth and sixth lines from the bottom.

6. The disclosure is objected to because of the following informalities: The description is replete with informalities. For example: 1) The Summary of the Invention section, i.e. a description of the invention of the claims, and the claims are still not commensurate, e.g. where is the invention of page 4, section 1 set forth in the claims? Note however the discussion *infra*. 2) The description of the Figures on pages 11-15 should be consistent with the Figures, e.g. where are Figures 7F-g, 11A-B and 14 described? 3) In the amended paragraph at page 4, line 1, the last line appears to be inaccurate, i.e. "absorber" should be --absorbent product--. 4) The description of the invention throughout the application is, at the very least, unclear/inconsistent (note the discussion *infra* also). For example, where is a detailed description of Figures 7F and G now set forth? For another example, a surface sheet is described as covering an upper surface of the absorber on lines 5-6 of claim 1 but is also described as providing the function of the last three lines of claim 1, i.e. "without being directly absorbed by the upper surface thereof". However, see, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph, the paragraph bridging pages 56-57 and Figures 1B and 6F, e.g. discharged liquid is supplied to the surface sheet, e.g. at the lower surface thereof, by being absorbed from lateral and lower surfaces of the absorber

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which liquid was also absorbed directly by the upper surface thereof, e.g. the portion of the absorber surface thereof not covered not fully covered longitudinally or the portion of the absorber surface thereof abutting the lateral terminal edges of the sheet. Note claims 2, 4, 6, and 30-31 with regard to the description in the last three lines of claim 1 also. Note the claim does not require “an upper surface” be the entire upper/uppermost surface of the absorber nor that the “discharged liquid supplied to the surface sheet” be discharged liquid directly supplied to and received by the upper/uppermost surface of the surface sheet. For a final example, the description of the various sheets in claims 26, 38, 27 and 39 and, e.g., page 45, first full paragraph, Figures 15A-B, 18A-18C, page 48, line 3-page 52, line 3 of the application are also unclear/inconsistent, e.g. Figure 15B shows a surface sheet, but does not show such between the main body and housing as claimed. Note discussion of Figure 15B supra. A clear consistent description throughout the application should be set forth. The entire description should be carefully reviewed and revised, as necessary. Applicant is thanked in advance for his/her cooperation in placing the description in proper form.

Appropriate correction is required.

7. The amendment filed 1-2-09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendments to pages 12, 26, 27, 28, 34, 35 and 39.

Applicant is required to cancel the new matter in the reply to this Office Action.

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Where is the invention, i.e. a description of the same scope, e.g. the description of portions 20/absorbent product of Figures 7F-G, the combinations of the relationships of 6A-6F and 7F-G, as originally filed, still described? Note MPEP 2163.02, second to last paragraph.

### ***Claim Objections***

8. Claims 26, 27-29, 32-34, and 38-39 are objected to because of the following informalities: In claim 26, line 8, “theabsorber” should be --the absorber--. In claim 38, the third to last line appears to include too many words, i.e. “that” should be deleted. Lines 2-5 of claim 32, i.e. “, 5....load,” would be in better form if amended as --(5 minutes after the beginning of the addition of 0.9 wt% sodium chloride solution in an amount equivalent to 50% of the total absorber absorbing capacity at 25 C under no load)--. In claim 34, lines 4-9, would also be placed in better form if rewritten, e.g., as --and an average re-wet amount after three additions of 100 mL of saline under no load, one said addition every 10 minutes, is 3 mL or less--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

9. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, a positive structural antecedent basis for “the discharged...sheet” on line 7 should be set forth. Also, as discussed supra, at the very least, see also the discussion infra, the description of the surface sheet on lines 1-8 and the function of the last three lines appear to be



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inconsistent (Note again, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph, the paragraph bridging pages 56-57 of the instant specification), i.e. if discharged liquid is supplied to the surface sheet, e.g. at the lower surface thereof, from lateral and lower surfaces of the absorber via absorption directly through the upper surface thereof, e.g. the portion of the absorber surface thereof not covered not fully covered longitudinally and/or the portion of the absorber surface thereof abutting the lateral terminal edges of the sheet, how can the liquid not be absorbed as claimed? It is noted that the claimed absorption is not limited to direct absorption from the upper side of the upper surface, i.e. the claim does not require “an upper surface” be the entire upper/uppermost surface of the absorber nor that the “discharged liquid supplied to the surface sheet” be discharged liquid directly supplied to and received by the upper/uppermost surface of the surface sheet. Claims 2, 4, 6 and 30-31 also appear to be inconsistent with the last three lines of claim 1, e.g. if a portion of the upper surface is exposed as claimed in claim 6, how can liquid supplied to the sheet not be absorbed by such exposed upper surface? Also, a positive antecedent basis for “the back sheet of the absorber” on the third to last line of claim 1 should be set forth. In claim 22, it is unclear whether the surface sheet, i.e. which is combined with the absorber, is also removeably received or not? In regard to claim 25, is the unit in claim 22 and at least one of the plurality of units in claim 25 one and the same, i.e. at a minimum how many units are being claimed? This also applies to claim 29. In claim 38, is the absorber in this claim and that in claim 1 one and the same? If so, how can the surface sheet, i.e. on the upper surface thereof, be between the main body and the housing as claimed on the last two lines but the absorber be received by the housing as claimed on the second and third lines from the bottom?

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10. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now claims an absorbent product with a surface sheet which is liquid-impermeable positioned on an upper side, a back sheet which is liquid-impermeable positioned on a lower side, and an absorber containing super absorbent polymer to absorb discharged liquid positioned between the surface sheet and the back sheet, wherein the surface sheet fully covers in a lateral direction, and partially or fully covers in a longitudinal direction, an upper surface of the absorber, and a flow passage is provided to allow a part or all of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber, the discharged liquid supplied to the surface sheet being absorbed from lateral and lower surfaces of the absorber without being directly absorbed by the upper surface thereof. However, as discussed supra in paragraphs 6 and 9, while the originally filed application, e.g. page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph and the paragraph bridging pages 56-57 of the instant specification, describes such product allowing a part or all of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber and discharged liquid supplied to the surface sheet, e.g. at the lower surface thereof, from lateral and lower surfaces of the absorber via absorption directly through the upper surface thereof, e.g. the portion of the absorber surface thereof not covered not fully covered longitudinally and/or the portion of the absorber surface thereof abutting the lateral terminal edges of the sheet, this is not what is

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claimed. Note again the claim does not require “an upper surface” be the entire upper/uppermost surface of the absorber and that the “discharged liquid supplied to the surface sheet” be discharged liquid directly supplied to and received by the upper/uppermost surface of the surface sheet. If Applicant maintains such language, the specific portion of the original specification which provides support for the entire scope of the combination of each claim in a single embodiment should be set forth.

11. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in MPEP 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written rejection. The language should focus on those factors, reasons and evidence that lead the examiner to conclude the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

First, what is the claimed invention? Claim 1 recites an absorbent product with a surface sheet which is liquid-impermeable **positioned on an upper side**, a back sheet which is liquid-impermeable positioned on a lower side, and an absorber containing super absorbent polymer to absorb discharged liquid positioned between the surface sheet and the back sheet, wherein the

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surface sheet **fully covers** in a **lateral** direction, and **partially or fully covers** in a **longitudinal** direction, **an upper surface** of the absorber, and a flow passage is provided to allow a part or all of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber, the discharged liquid supplied to the surface sheet being absorbed from lateral and lower surfaces of the absorber **without being directly absorbed by the upper surface** thereof. (Emphasis added).

However, see, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, pages 18, 19 and 24, first full paragraph and the paragraph bridging pages 56-57, if discharged liquid is supplied to the surface sheet, e.g. at the lower surface thereof, from lateral and lower surfaces of the absorber via absorption directly through the upper surface thereof, e.g. the portion of the absorber surface thereof not covered not fully covered longitudinally and/or the portion of the absorber surface thereof abutting the lateral terminal edges of the sheet, how can the liquid not be absorbed as claimed as now claimed in last three lines of claim 1, i.e. without being absorbed by the upper surface? Note the invention claimed in the dependent claims also, e.g. claim 6, i.e. if a portion of the upper surface is exposed, how can liquid supplied to the sheet not be absorbed by such exposed upper surface? Therefore, at the very most, note the discussion in paragraphs 6 and 9-10 supra also, the claimed subject matter is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Claim Language Interpretation***

12. With regard to claim 1 and thereby the claims which depend therefrom, see paragraph 10 and thereby, MPEP 2163.06, I. Therefore, claim 1 is interpreted to require an absorbent product structured as claimed on lines 1-9 which functions with regard to discharged liquid as claimed on the last three lines. Note however the discussion in paragraphs 6, 9 and 11 supra also. Also, due to the lack of antecedent basis the side on the third to last line of claim 1 will be interpreted as some side of the back sheet. In claim 20, the terminology “means” on line 3 is interpreted not to invoke 35 USC 112, sixth paragraph. Claim 20 is also a product by process claim, see MPEP 2113, i.e. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.” The end product of claim 20 is considered to be a liquid-permeable non-woven fabric with a coat of super absorbent polymer. “Coat” is defined by the dictionary as “a layer of one substance covering another” (emphasis added). Due to the lack of clarity set forth supra, claim 22 is interpreted to require the sheet also be removeably received. Claim 25 is interpreted to require at least one laminated absorber unit in addition to the unit of claim 22. This interpretation also applies to claim 29. Claim 38 is interpreted to require the surface sheet between the internal space and the absorber.

***Response to Arguments***

13. Applicant's remarks have been carefully considered but are deemed either moot in that the issue discussed has not been reraised of deemed not persuasive for the reasons set forth supra. The claims as now amended, note again paragraph 10 and MPEP 2163.06, I, distinguish over the prior art. However again note the discussion in paragraphs 6, 9 and 11 supra and paragraph 14 infra.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art show absorbent products in which an uppermost surface portion of an absorber is covered by a sheet and discharged liquid directly supplied to and received by an uppermost surface of such surface sheet is not directly absorbed by such covered absorber uppermost surface portion.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/  
Primary Examiner, Art Unit 3761

March 24, 2009